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PATENT

(Docket No. IN-5453)

OFFICIAL

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Horst HINTZE-BRÜNING et al.

Serial No.: 09/762,030

Filed: March 2, 2001

For: Film and the Use Thereof for Coating  
Shaped Parts

Group Art Unit: 1774

Examiner: Lawrence D. Ferguson

I hereby certify that the attached correspondence is being transmitted  
via facsimile addressed to Commissioner for Patents, PO BOX 1450,  
Alexandria, VA 22313-1450, on the date shown below to facsimile  
number 1-703-872-9306.1-20-2004  
Date

Michael Monahan

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION

In response to the Office Action mailed on October 10, 2003, Applicants respond through  
their attorney as follows.

## REMARKS

The claims pending in the subject application are 1-4, 6-11, 13-16, and 18.  
Reconsideration of this application based on the Remarks presented herein is respectfully  
requested.

The shortened statutory period for response expired on January 10, 2004. Accordingly, a  
Petition for a One-Month Extension of Time is attached hereto. The Director - U.S. Patent and  
Trademark Office is hereby authorized to charge Deposit Account 23-3425 the necessary  
extension fees identified in the attached Petition and any other fees necessary for entry of this  
amendment.

**35 U.S.C. §103 REJECTIONS**

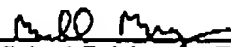
Claims 1-4, 6-11, 13-16, and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over EP844286.

In EP844286, there is no disclosure or suggestion for the substrate to which the powder coating is applied to be a film. While the substrate can be plastic (page 12, lines 11-14), there is no disclosure or suggestion of a film. A film has a different structure than an automotive part.

The argument that the thickness of the support layer could be optimized applies if and only if the cited reference disclosed a film structure. If a film were disclosed, then the argument about optimizing the film thickness might apply. But EP844286 does not disclose or suggest a film. Because a film structure is not disclosed or suggested, there can be no optimization of a property of a film, e.g., its thickness. What is being suggested by the current argument of optimizing film thickness is a transformation of a structure into a structure that is not disclosed or suggested by the reference. This is similar to a reference disclosing a bread box, and then asking that the bread box be pressed into a foil. There is no motivation in EP844286 to transform the disclosed structures into a film. Because there is no disclosure or suggestion of the "support layer" for the coating layer as claimed, it is respectfully submitted that claims 1-4, 6-11, 13-16, and 18 are patentable over EP844286.

In view of the remarks contained above, Applicants respectfully request reconsideration of the application, withdrawal of the 35 USC §103 rejections, and request that a Formal Notice of Allowance be issued for claims 1-4, 6-11, 13-16, and 18. Should the Examiner have any questions about the above remarks, the undersigned attorney would welcome a telephone call.

Respectfully submitted,

  
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Date: 20 January 2004